



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

(J)

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
| 09/012,272 | 01/23/98 | LEE | 028870-080 |

HM22/0119

RONALD L GRUDZIECKI
BURNS DOANE SWECKER & MATHIS
P O BOX 1404
ALEXANDRIA VA 22313-1404

EXAMINER

PAK, J

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1616

DATE MAILED: 01/19/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/012272

Applicant(s)

Lee et al.

Examiner

Pak, J.

Group Art Unit

1616

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 10/23/98
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-4 and 6-9 is/are pending in the application.
- ☐ Of the above claim(s) is/are withdrawn from consideration.
- ☐ Claim(s) is/are allowed.
- ☒ Claim(s) 1-4 and 6-9 is/are rejected.
- ☐ Claim(s) is/are objected to.
- ☐ Claim(s) are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) .
 - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received:

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other

Office Action Summary

Art Unit: 1616

Claims 1-4 and 6-9 are now pending in this application.

In applicant's reply of 10/23/98, there is a reference to a telephone conversation conducted after the personal interview on 10/15/98. It is noted that this telephone conversation was not made of record in an interview summary record, because there, Mr. Baum merely acknowledged after the personal interview that he understood more clearly the Examiner's position regarding incorporation of an active such as an anti-inflammatory. The substantive discussion regarding the case is recorded in the personal interview summary record of Paper No. 4.

Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In applicant's reply of 10/23/98, claim 6 is noted as "(amended)" but no amendatory change can be discerned. Further, applicant should end the claim with a period and denote the percentages as weight percentages. The subject matter of claim 6 is unclear to the extent that the amendatory changes cannot be understood. Applicant is advised that clarification of these matters and reintroduction of the claim in independent form, incorporating all of the limitations of claim 1 into claim 6, would result in an allowable claim.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 1616

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4 and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bonfield et al. in view of Shimono et al. for the reasons of record.

Applicant's arguments have been given due consideration, but were deemed unpersuasive. First, for the reasons of record, the Examiner maintains his position that (i) the inventive subject matter is still readable on incorporation of active anti-inflammatory agents into bioactive glass, and (ii) use of such anti-inflammatory active agent containing bioactive glass to provide skin inflammation treatment would have been obvious to the ordinary skilled artisan. The invention claimed, to the broad extent that it is readable, is therefore obvious within the meaning of section 103. Second, while applicant asserts "novel method of treating inflammation" with bioactive glass per se, his objective evidence of such novelty, and nonobviousness, is only directed to bioactive glass "45S5"¹. The independent claim 1 requires only SiO₂, CaO and P₂O₅. Note that this is the most rudimentary description of glass in general, and it does not even require the presence of Na₂O, which is present at 24.5 wt% in "45S5." Plainly applicant's objective evidence of nonobviousness, if any, is not commensurate in scope with that of the claimed subject matter. In re Kulling, 14 USPQ2d 1056, 1058 (Fed. Cir. 1990); In re Lindner, 173 USPQ 356, 358 (CCPA 1972).

¹ It is noted that the makeup of "45S5" is recited in claim 6.

Art Unit: 1616

For these reasons, all claims must be refused. No claim is allowed at this time.

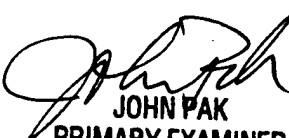
Applicant is advised that U.S. Patent 5,840,290 is cited to further show the state of the art.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

A facsimile center has been established in Technology Center 1600. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machines are (703) 308-4556 or (703) 305-3592. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Examiner Pak whose telephone number is (703) 308-4538. The Examiner can normally be reached on Monday through Thursday from 8:00 AM to 5:30 PM. The Examiner can also be reached on alternate Fridays. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. José Dees, can be reached on (703) 308-4628. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.


JOHN PAK
PRIMARY EXAMINER
GROUP 1600